

ARGUMENTS/REMARKS

The application has been carefully reviewed in light of the Office action, and the personal interview conducted on October 26, 2004, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 3-13, 22, 48, 54-55, 72-75, and 78-82 remain in this application. Claims 1-2, 20, 23-32, 39-47, 49, 56-71, 76-77, and 83 have been canceled. Claims 14-19, 21, 33-38, 50-53, and 71 were withdrawn due to an earlier restriction requirement. Applicant reserves the right to present these withdrawn or canceled claims in a divisional application. New claims 84-90 have been added.

Claims 67-70 were rejected under 35 U.S.C. §112, fourth paragraph. These claims have been canceled, making the rejection moot.

Claims 1-8, 23-25, 39-45, 48-49, and 54-70 were rejected under 35 U.S.C. §103(a) as being unpatentable over Walker *et al.* (U.S. '396) in view of Sasmazel *et al.* (U.S. 6,032,260). Claims 9-13, 22, 54, and 72-83 are rejected as above in further view of Hughes, and claims 26-30 are rejected as being unpatentable over Walker in view of Sasmazel and further in view of Kwan. For the following reasons, the rejection is respectfully traversed.

New claims 84-87 and 89 have replaced the previous independent claims. These claims recite a server (or an issuing step) issuing both an "exchange certificate" and an "electronic asset" with the "electronic asset corresponding to" and transmitted "in exchange for" the exchange certificate. None of the cited references suggest any such embodiments.

The Examiner relies on Walker for teaching the "exchange certificate" and the "electronic asset" of the claims. As has been discussed in great detail in the appeal brief previously filed in this case, and at the personal interview, Walker does not suggest the exchange certificate of the invention, as limited by the claim language.

As was also discussed in the appeal brief and at the personal interview, Walker teaches a system enabling ticket purchasers to be matched with ticket sellers. The ticket purchaser makes an *offer* to a seller, and the seller can accept the offer or not. If the seller accepts the offer, the purchaser may or may not be required to purchase the ticket (depending

on whether the offer was conditional or guaranteed, and whether the conditions were met). Finally, if the offer/acceptance is completed, the seller transfers the tickets to the purchaser.

The Examiner states that the purchase “offer” of Walker’s purchaser teaches the exchange certificate of the invention, despite the fact that the “offer” does not represent a “right” to the electronic asset (any attorney will agree that an offer is never binding on the seller unless the offer is accepted). Further, an offer cannot be “exchanged” for an electronic asset for the same reasons.

In addition, the new claim language specifically states that the exchange certificate is transmitted in response to an order, with the order being in response to an offer by a vendor for a service or product. Thus, the claims recite elements analogous to the “offer” of Walker, namely the offer of the vendor to sell a service or product. However, there is no teaching in Walker that suggests the exchange certificate of the invention.

At the personal interview, it was discussed at length that the “exchange certificate” is an intermediate device that proves a user has a right to an electronic asset, but by itself, cannot be used in trade for the product or service. In contrast, Walker discusses a simple auction, where a ticket purchaser makes an offer to purchase a ticket from a ticket seller, and the seller sells the ticket to the purchaser in exchange for money. There is nothing in the Walker reference that suggests an intermediate item that is issued in response to a purchase, but cannot, itself, be exchanged for the product or service. Instead, the exchange certificate of the claims must first be exchanged for the electronic asset, and then the electronic asset (not the exchange certificate), can be exchanged for the product or service.

Sasmazel does not overcome the above cited Walker shortcomings.

Consequently, for above reasons, Walker does not teach the “exchange certificate” of the invention, and the claims are patentable over the references

Furthermore, new claims 84-86 recite that the electronic asset be issued on a “predetermined date and time”. The Examiner cites Sasmazel as teaching this limitation of the claims at col. 8, lines 26-44. However, a close reading of Sasmazel does not support the Examiner’s assertion.

In the cited portion of Sasmazel, the reference discusses the expiration date and time

of an eticket. There is no discussion at all about *issuing* an eticket at a predetermined date and time. Sasmazel teaches that an expired eticket might be updated or not, depending on whether the user is in session. However, there is no discussion at all about issuing an electronic asset at a predetermined date and time, as recited in the claims.

Thus, for this reason as well, claims 84-86 are patentable over the references.

Further, the Examiner has failed to provide the proper motivation for combining the references. The Examiner argues that because Walker teaches that offers are "time limited", that this provides motivation for seeking a reference teaching issuing an electronic asset at a predetermined date and time.

Even if Walker does teach that for which it is cited, the Examiners conclusion that this motivates one to issuance of an electronic asset at a "predetermined date and time" does not follow. If an offer is "time limited", this would, at most, motivate one to accept the offer merely before the expiration date. There is no reason to accept the offer at a predetermined date and time. Thus, the Examiner's motivation is clearly faulty, and would not lead one to the cited solution.

Further, the Examiner argues that the motivations for adding Hughes and Kwan are nothing more than the *benefits* of their teachings. It is not proper to merely rely on a benefit of a teaching for adding that teaching to another reference. If such were considered proper motivation, then every reference would be self-motivating, and thus every invention would be obvious because such an argument can ALWAYS be applied to any new combination. Clearly, this is improper.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32410.

Respectfully submitted,

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